

### REMARKS/ARGUMENTS

The claims are 2-9. Claims 7-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Stanchfield* U.S. Patent No. 6,860,074. Claims 2-3 and 5-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Stanchfield* in view of *Neuhofer* U.S. Design Patent No. D542,941. Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Stanchfield* in view of *Neuhofer* and further in view of *Kemper* U.S. Patent No. 6,345,480.

In response to Applicant's arguments made in a January 26, 2008 Response to the October 24, 2008 Final Office Action, the Examiner issued an Advisory Action on February 17, 2009 indicating that Applicant had simply made arguments directed to the novelty of the invention whereas the rejection was an obviousness rejection made under 35 U.S.C. 103. The Examiner also indicated that arguments directed against references separately will not overcome an obviousness rejection that uses those references in combination.

The Examiner's rejections are respectfully traversed and reconsideration is expressly requested.

As set forth in claim 9, Applicant's invention provides a profiled cover made of an extruded profile for floor coverings. The profiled cover includes a covering flange, at least one clamping web protruding downward from the covering flange, extending in a longitudinal direction of the profiled cover and fastening the profiled cover to a fixture, a compensating strip fastened to the covering flange, and a form-fitting tongue and groove joint fastening the compensating strip to the covering flange. As recited in claim 9, the tongue and groove joint includes at least one longitudinal groove in an underside of the covering flange for retaining a tongue projecting into the groove from the compensating strip, the section of the covering flange in which the groove is located being supported flat over the floor coverings they cover. In this way, Applicant's invention provides a profiled cover that with a compensation strip can cover floor coverings with an exact fit while still being simple to manufacture.

The Examiner has taken the position that because all of the elements of Applicant's profiled cover as recited in claim 9 are shown in *Stanchfield*, albeit in a different arrangement, it would have been obvious to one of routine skill in the art to rearrange the elements of the profiled cover shown in *Stanchfield* to make Applicant's profiled cover as recited in claim 9. The Examiner

relied on *In re Einstein* 46 F.2d 373, 8 U.S.P.Q. 166, 167 (1931) for the doctrine that "a mere reversal of the essential working parts of a device only involves routine skill in the art."

It is respectfully submitted that Applicant's profiled cover as recited in claim 9 does not represent a "mere" reversal of the working parts of *Stanchfield*.

As instructed by the Court of Customs and Patent Appeals in *Einstein*, if a new and useful purpose is accomplished by a rearrangement of working parts shown in the prior art, then the new arrangement is not obvious. 46 F.2d at 374. With the profiled cover as recited in Applicant's claim 9, a new and useful purpose is achieved as the profiled cover is versatily able to both cover two floor surfaces of the same height by having the body of the covering flange rest flat over the floor surfaces, and also is able under other circumstances to cover floor surfaces of differing heights with the help of a compensating strip, without having to detach any portion of the covering flange.

All of the covering flange/compensation strip combinations in the prior art cited by the Examiner disclose grooves in the compensation strip and tongues in the covering flange, except for the combination shown in FIGS. 13A and 13B of *U.S. Patent Application Publication No. 2003/0159389 to Kornfalt et al.* The combination shown in these figures of *Kornfalt et al.* also does not show a groove in the body of the covering flange, and only shows a groove in projections 1380 and 1381 attached to the covering flange that project away from the body of the covering flange.

No combination of covering flange and compensation strip of the prior art cited by the Examiner achieves the purpose of covering either two floor surfaces of the same height by having the body of the covering flange rest flat on the floor surfaces or under other circumstances of covering floor surfaces of differing heights with the help of a compensating strip, without having to detach any portion of the covering flange. The covering flange/compensation strip combination shown in FIGS. 13A and 13B of *Kornfalt et al.* would require the projections 1380 and 1381 to be cut off before the body of the covering flange could rest flat on a floor surface.

It should be noted that *Einstein* did not involve the situation where those of routine skill in the art would consider

it *undesirable* to rearrange the elements of the prior art to form the disputed invention. In contrast, before Applicant's invention it was clear to one of routine skill in the art of floor coverings that it was undesirable to produce covering flanges with grooves in the body of the covering flange because of the weakening effect on the profiled cover. It was thought that a covering flange should not be weakened in that manner because the covering flange receives the initial impact of people walking on the floor. This recognition by those of ordinary skill in the art is evidenced by the profiled covers in the prior art cited by the Examiner which show no grooves in the body of covering flanges.

Accordingly, it is respectfully submitted that Applicant's profiled cover as recited in claim 9 cannot be considered a mere reversal of parts in view of the new and useful purpose achieved by Applicant's profiled cover as recited in claim 9 and the manifest teaching away from the arrangement set forth in Applicant's claim 9 as evidenced by the cited prior art. Accordingly, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness.

In addition to teaching away, there is further evidence of "secondary consideration" or objective evidence of nonobviousness present here in the form of the unexpected result of versatility

achieved by Applicant's profiled floor cover as recited in claim 9.

This benefit of versatility, as described above, results from providing a groove in the underside of the body of the covering flange instead of a tongue in the underside of the covering flange. If a combination of features not shown in the prior art produces unexpected results, a *prima facie* case of obviousness can be rebutted. See MPEP at 2141 IV and V. Thus, the Examiner's position that Applicant's combination of a covering flange with a groove on its underside and a compensation strip with a tongue that fits in the groove, which combination is not shown in the prior art, would have been obvious to one of routine skill in the art as a mere reversal of essential working parts of the device of *Stanchfield*, is rebutted, *inter alia*, by the unexpected results that occur with Applicant's novel combination.

This argument of unexpected results as a rebuttal to any *prima facie* case of obviousness of Applicant's profiled cover as recited in claim 9 was made previously by the Applicant in the Applicant's January 26, 2009 Response to the Final Office Action. See, e.g., pages 3-7 of Applicant's January 26, 2009 Response.

The Examiner failed to respond to this argument of the Applicant in the Examiner's Advisory Action of February 17, 2009.

As set forth in claim 7, Applicant's invention provides a method for the production of a profiled cover and at least one compensating strip for a covering device for floor coverings in accordance with claim 9. As recited in claim 7, the extruded profile firstly is produced. The cross-section of the extruded profile consists of the cross-sections of the profiled cover and at least one compensating strip, with the strip being connected to the subsequent profiled cover by means of a connecting land serving as a spacer. Then the compensating strip is separated from the profiled cover with a separating cut through the connecting land. Claim 8 depends on claim 7 and thus includes these steps for producing a profiled cover.

Whereas Applicant's covering device as recited in claim 9 is not obvious to one of routine skill in the art, as explained above, it is also not obvious to one of routine skill in the art to produce Applicant's covering device. Therefore claims 7 and 8 for the method for the production of Applicant's covering device should be allowed as patentable over the cited prior art reference of *Stanchfield*.

Moreover, it is respectfully submitted that none of the cited references discloses or suggests a method for the production of a profiled cover having the specific process steps recited in claim 7, including the connection crosspieces as recited therein. Although the Examiner apparently has taken the position that such connection crosspieces are shown in *Stanchfield*, it is respectfully submitted that the Examiner's position is unfounded. Accordingly, it is respectfully submitted that claim 7, together with claim 8 which depends thereon, is patentable over the cited references.

Claims 2-6 depend on claim 9 and recite features in addition to those set forth in claim 9. Whereas Applicant's covering device as recited in claim 9 is not obvious to one of routine skill in the art, and both of the secondary references of *Neuhofer* and *Kemper* fail to disclose the unexpected results of versatility in ability of the covering flange to cover floor surfaces of the same height directly or floor surfaces of varying heights with the help of a compensating strip, claims 2-6 are not obvious to one of routine skill in the art and should be allowed as patentable over *Stanchfield* and *Neuhofer* or *Stanchfield* and *Kemper*.



Claim 3 is dependent on claim 2 and further specifies that the compensating strip is provided with at least one supporting leg projecting from the leg with the tongue. This supporting leg provides additional support for the covering flange on the floor surface. The part of the compensating strip of *Neuhofer* relied on by the Examiner to be a supporting leg projecting from the leg with the tongue is identified by the Examiner with the reference number 5. Part 5, however, is not a supporting leg projecting from the leg with the tongue. A supporting leg rests on the floor surface. Because part 5 of *Neuhofer* is not the same length as the leg, that extends downward, of the angled compensating strip (marked by 3 by Examiner), part 5 does not rest on the floor surface and is not a supporting leg. Part 5 requires coupling to an extension of the floor surface and so at most should be considered a "coupling projection" and not a "supporting leg". This feature of a supporting leg projecting from a leg with a tongue of an angled compensating strip, as recited in Applicant's claim 3, is also not found in *Stanchfield*. Therefore, any hypothetical combination of *Neuhofer* and *Stanchfield* would fail to produce Applicant's profiled floor covering as recited in claim 3. Accordingly, claim 3 is patentable over the cited references for this additional reason.

Claim 5 is dependent on claim 2 and further specifies that the compensating strip is provided with a peripheral projection on the leg adjacent to the covering flange to serve as a retaining lug, wherein the projection engages a longitudinal groove that serves as a retaining recess on an underside of the covering flange or on the side of the clamping web of the profiled cover facing the compensating strip which forms a pivot axis for the compensating strip. This arrangement allows the resultant torque loads, to which the compensating strips supported on the floor surface by the leg or the supporting leg are subjected, to be transferred without the risk of the tongue and groove joint releasing, until the primary tongue on the compensating strip engages the groove of the underside of the covering flange.

The Examiner has taken the position that this feature of Applicant's profiled floor covering as recited in claim 5 is shown in Figure 18 of *Stanchfield*, which shows a tongue 218 that inserts into a groove 219 of the clamping web of the profiled cover; however, because tongue 218 has a square or rectangular shape, and groove 219 has a square or rectangular shape, compensating strip 219 will not be able to use this connection as a pivot axis for assembly of the profiled cover. Pivoting with the angled edges of the tongue 218 and groove 219 of the cover

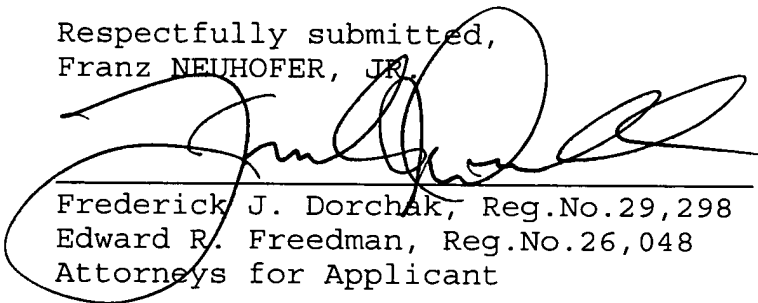
shown in Figure 18 of *Stanchfield* will result in the tongue 218 being broken off of the compensating strip. In contrast, the peripheral projection of Applicant's compensating strip has rounded edges, as shown in Figures 7 and 8 of Applicant's specification, which will allow the peripheral projection to form a pivot axis with the longitudinal groove, which will help the primary tongue of the compensating strip connect to the groove in the underside of Applicant's profiled cover as recited in claim 5 during assembly.

*Neuhofer* also fails to show a peripheral projection in the compensating strip that engages a longitudinal groove of the underside of the covering flange or a side of the clamping web of the profiled cover, wherein the peripheral projection and the longitudinal groove form a pivot axis for the compensating strip. Thus, as both *Neuhofer* and *Stanchfield* fail to show this feature of Applicant's profiled cover as recited in claim 5, any hypothetical combination of *Neuhofer* and *Stanchfield* fails to disclose Applicant's profiled cover as recited in claim 5. Therefore, Applicant's profiled cover as recited in claim 5 is not obvious in view of the cited prior art references for this additional reason, and is patentable over the cited prior art references.

Accordingly, it is respectfully submitted that claims 2-9 are patentable over the cited references.

In view of the foregoing, it is respectfully requested that the claims be allowed and that this case be passed to issue.

Respectfully submitted,  
Franz NEUHOFER, JR.



Frederick J. Dorchak, Reg.No.29,298  
Edward R. Freedman, Reg.No.26,048  
Attorneys for Applicant

COLLARD & ROE, P.C.  
1077 Northern Boulevard  
Roslyn, New York 11576  
(516) 365-9802

**Express Mail No. EM 306 824 193 US**  
**Date of Deposit: February 24, 2009**

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, on the date indicated above, and is addressed to Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
\_\_\_\_\_  
Amy Klein

R:\Patents\N\NEUHOFER, JR-16 PCT\Preliminary response in RCE.wpd

### REMARKS/ARGUMENTS

The claims are 2-9. Claims 7-9 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Stanchfield* U.S. Patent No. 6,860,074. Claims 2-3 and 5-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Stanchfield* in view of *Neuhofer* U.S. Design Patent No. D542,941. Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Stanchfield* in view of *Neuhofer* and further in view of *Kemper* U.S. Patent No. 6,345,480.

The Examiner's rejections are respectfully traversed and reconsideration is expressly requested.

As set forth in claim 9, Applicant's invention provides a profiled cover made of an extruded profile for floor coverings. The profiled cover includes a covering flange, at least one clamping web protruding downward from the covering flange, extending in a longitudinal direction of the profiled cover and fastening the profiled cover to a fixture, a compensating strip

fastened to the covering flange, and a form-fitting tongue and groove joint fastening the compensating strip to the covering flange. As recited in claim 9, the tongue and groove joint include at least one longitudinal groove in an underside of the covering flange for retaining a tongue projecting into the groove from the compensating strip, the section of the covering flange in which the groove is located being supported flat over the floor coverings they cover. In this way, Applicant's invention provides a profiled cover that is able to fulfill the requirements for the exact fit of a profiled cover and compensation strip while still being simple to manufacture.

Those of ordinary skill in the art of floor coverings readily recognize that a connecting groove in an underside of a covering flange decisively weakens the flange. Thus, covering flanges known in the art have almost exclusively been made without grooves on their underside. None of the prior art cited by the Examiner discloses a covering flange with a groove on its underside, except for *U.S. Patent Application Publication No. 2003/0159389 to Kornfalt et al.* in FIGS. 13A and 13B. This

groove shown in Kornfalt et al. is made by an empty space between two walls 1380 and 1381 projecting from the covering flange downward and is not made by leaving an indentation in the body of the covering flange itself. These projections 1380 and 1381 prevent this section of the covering flange from being supported flat over the floor coverings they cover, so that covering flange is still weakened according to the expectations of those of skill in the art, as described above. Only by cutting away projections 1380 and 1381 would the covering flange be supported flat over the floor coverings, as is accomplished by Applicant's invention as recited in claim 9.

Applicant's profiled cover as recited in claim 9 achieves the unexpected result of avoiding a weakened covering flange and providing a versatile covering device that can cover floor coverings with a greater variety of heights. As described previously, the section of the covering flange in which the groove is located is supported flat over the floor covering that it covers. The section of the covering flange with a groove on its underside, into which the tongue of a compensating strip

fits, also is supported flat over the compensating strip so that the covering flange is not weakened in operation by the presence of this second groove.

Applicant's profiled cover as recited in claim 9 also achieves an unexpected versatility in comparison to the prior art because the covering device can be used to cover floor coverings of a greater variety of heights. A side of Applicant's covering flange with a groove could be placed over a floor panel and a compensating strip with a tongue, and can alternatively be placed directly on a floor panel. In contrast, the covering devices as known in the prior art, as shown in *U.S. Patent Application Publication No. 2003/0154678 to Stanchfield*, have lugs (tongues) (18 in FIG. 1) on the underside of the covering flange (12 in FIG. 1) and cannot be placed effectively directly onto floor panels, because the lug (tongue) that projects from the underside of the covering flange would interfere with the resting of the covering flange directly on a floor panel. The lug (tongue) of the covering flanges of the prior art would need to be cut off for the covering flange to effectively rest directly on a floor



panel. Thus, even if the Examiner is correct that the elements of Applicant's covering device were known in the prior art in a different arrangement, these unexpected results from the Applicant's combination of the elements rebut and overcome the obviousness determination made by the Examiner.

Contrary to the Examiner's position, none of the cited references discloses or suggests a profiled cover having the structure recited in claim 9 or teach the benefits of a tongue and groove joint formed by at least one longitudinal groove in an underside of the covering flange for retaining a tongue projecting into the groove from a compensating strip. As the Examiner has recognized, *Stanchfield* fails to disclose or suggest such a structure. Although the Examiner has taken the position that it would have been obvious to a person skilled in the art to move the groove 42 to the cover 12, it is respectfully submitted that the Examiner's position is incorrect.

As discussed above, one skilled in the art would not move the groove of the tongue groove connection between the cover

flange and the equalization strip to the underside of the cover profile because the cover flange would be decisively weakened as a result. For this reason, *Stanchfield* shows that the tongue 18 always lies on the underside of the cover flange and the groove lies in the equalization strip.

In fact, as mentioned above, the only prior art in which the groove is moved to the underside of the cover flange of the cover profile is *Kornfalt et al.* which is not relied on by the Examiner. In *Kornfalt et al.*, projections are provided that project away from the underside of the cover flange. These projections that project beyond the underside of the cover flange, however, have the disadvantage that they prevent area contact of the cover flange with a floor covering on the side of these projections that delimit these grooves unless these projections are cut away. Thus, as recited in Applicant's claim 9 the cover profile 4 can be laid flat on both sides of the clamping cross piece 7 that projects downward onto floor coverings 1 that follow on both sides as must be the case if this cover profile merely covers an expansion joint between two floor

coverings 1 of equal height which is by no means the case in *Stanchfield* and which it is respectfully submitted cannot be made obvious by *Stanchfield* for the reasons set forth previously.

Claim 2 is dependent on claim 9 and further specifies that the compensating strip has the basic form of an angle section with two legs, with the leg having the tongue being adjacent to an underside of the covering flange of the profiled cover and the other forming an extension of the profile cover extending downward. It is respectfully submitted that this feature is nowhere disclosed or suggested by *Stanchfield*. Although the Examiner relies on the secondary reference to *Neuhofer* as disclosing this feature, it is respectfully submitted that the Examiner's position is unfounded. The equalization strip according to *Neuhofer* does not represent an angle profile that rests against the cover flange with one shank and forms an extension of the cover profile that drops downward with the other flank. Instead, the equalization strip according to *Neuhofer* shows a compact strip body having a longitudinal groove that serves for attachment of the equalization strip to a clamping

crosspiece of a floor holder device. Accordingly, it is respectfully submitted that claim 2 is patentable for this additional reason.

Claim 3 is dependent on claim 2 and further specifies that the compensating strip is provided with at least one supporting leg projecting from the leg with the tongue. Thus, an additional protective crosspiece is required, which projects away downward from the shank of the equalization strip having the engagement projection. The part of the equalization strip of *Neuhofer* indicated with 5 relied on by the Examiner, however, cannot yield such a support crosspiece because this part 5 has a lesser height than the part 3. The part 5 can at most be compared with the coupling projection 16 according to Applicant's claim 4; however, the support crosspiece required according to claim 3 is absent in *Neuhofer*. Accordingly, it is respectfully submitted that claim 3 is patentable over the cited references for this additional reason.

As set forth in claim 7, Applicant's invention provides a

method for the production of a profiled cover and at least one compensating strip for a covering device for floor coverings in accordance with claim 9. As recited in claim 7, the extruded profile firstly is produced. The cross-section of the extruded profile consists of the cross-sections of the profiled cover and at least one compensating strip, with the strip being connected to the subsequent profiled cover by means of a connecting land serving as a spacer. Then the compensating strip is separated from the profiled cover with a separating cut through the connecting land.

Whereas Applicant's covering device is not obvious to one of ordinary skill in the art, as explained above, it is also not obvious to one of ordinary skill in the art to produce Applicant's covering device. Therefore claims 7 and 8 for the method for the production of Applicant's covering device should be allowed as patentable over the cited prior art reference of *Stanchfield*.

Moreover, it is respectfully submitted that none of the

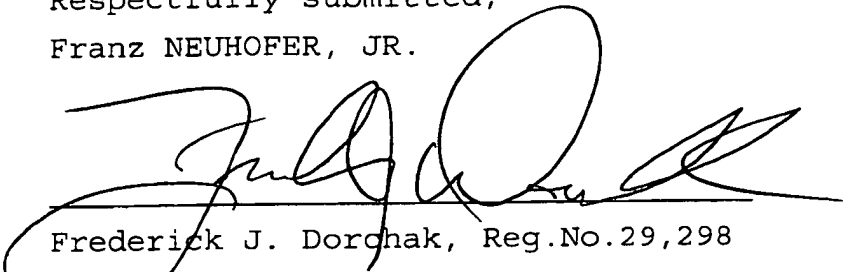
cited references discloses or suggests a method for the production of a profiled cover having the specific process steps recited in claim 7, including the connection crosspieces as recited therein. Accordingly, it is respectfully submitted that claim 7, together with claim 8 which depends thereon, is patentable over the cited references.

The remaining reference to *Kemper* which has been cited with respect to claim 4 has been considered but is believed to be no more relevant. Like *Stanchfield* and *Neuhofer*, *Kemper* fails to disclose or suggest a profiled cover made of an extruded profile for floor coverings wherein the tongue and groove joint includes at least one longitudinal groove in an underside of the covering flange for retaining a tongue projecting into the groove on the compensating strip, the section of the covering flange in which the groove is located being supported flat over the floor coverings they cover.

Accordingly, it is respectfully submitted that all claims are patentable over the cited references.

In view of the foregoing, withdrawal of the final action and allowance of this application are respectfully requested.

Respectfully submitted,  
Franz NEUHOFER, JR.



Frederick J. Dornhak, Reg.No.29,298  
Edward R. Freedman, Reg.No.26,048  
Attorneys for Applicant

COLLARD & ROE, P.C.  
1077 Northern Boulevard  
Roslyn, New York 11576  
(516) 365-9802

FJD:cmm

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: MAIL STOP: AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on January 22, 2009.



Amy Klein